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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hiroyasu Sugano

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EXAMINER

NALVEN, ANDREW L

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/816,125

Applicant(s)

SUGANO ET AL.

Examiner

Andrew L. Nalven

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 6-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 2-4 and 6-22 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed 8/16/2006 have been fully considered but they are not persuasive.
3. Applicant has argued on pages 14-15 that the Theimar reference differs from the claimed invention because in the Theimar reference the statuses of the users are directed to a physical status of the user while the claimed invention's statuses are directed towards psychological and physical states. Examiner notes, without agreeing or disagreeing with Applicant's characterization of the statuses in both cases, that the claims as currently presented are directed only to a general "storing of statuses of the users." Thus, Applicant's assertion regarding the differences between Theimar and the claimed invention is without merit because the claimed invention does not provide any specificity to the type of statuses used.
4. Applicant has argued on page 15 that the Theimar reference fails to anticipate the claimed communication requests because Theimar discloses RPC requests. Examiner respectfully disagrees. Theimar's RPC requests are communication requests. Applicant characterizes Theimar's RPC requests as a form of "information delivery" and selectively "delivering electronic messages." These are forms of

communication requests. The claims as currently presented do not provide any specificity to the type of communications used. Thus, Examiner maintains that the claimed communication requests are anticipated by Theimar's RPC calls.

5. Applicant further argues on page 15 that the Theimar reference's processing policies are directed towards forms of communication rather than content whereas the current invention is directed towards processing policies that consider the relationship between a first user and a second user. Examiner respectfully disagrees. Theimar's processing policies consider a first user from whom there is a request for communication with a second user (Theimar, column 11 lines 3-6), to status of the second user with whom communication is requested (Theimar, column 10 line 67 – column 11 line 3), to content of the requested communication (Theimar, column 14 lines 43 – column 15 line 4). Theimar teaches that content of the communication is considered as part of the processing policy (Theimar, column 14 lines 47-48) and gives an example of an "urgent message" type of content (Theimar, column 14 lines 62 – column 15 line 5).

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 2-6 and 9-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Theimar et al US Patent No 5,493,692. Theimar teaches a system for selective delivery of messages between multimedia computers based upon context and environment of the user.

8. With regards to claim 2, Theimar teaches the storing of statuses of the users (Theimar, column 7 lines 1-16, Figure 3), the preparing of a processing policy in which processes for communication requests are set for each of the users (Theimar, column 14 line 62 – column 15 line 15), the processes each in turn being according to a first user from whom there is a request for communication with a second user (Theimar, column 11 lines 3-6), to status of the second user with whom communication is requested (Theimar, column 10 line 67 – column 11 line 3), to content of the requested communication (Theimar, column 14 lines 43-48 and column 14 lines 62-64), the processing policy including an attribute-assigning policy setting a relationship between the first user requesting communication to the second user (Theimar, column 11 lines 3-6, “policies restricting responses to a subset of all possible clients”, column 7 lines 7-17 “interaction policies”), and storing the attribute-assigning policy (Theimar, column 9 lines 60-67). Theimar also discloses that when a request for communication occurs, there is a step of looking up the attribute-assigning policy and information of the first user and the second user (Theimar, column 10 line 66 – column 11 line 17, “check the current settings of the user’s policy” and “response contains information about the user and/or UserAgent that the client is interested in”), determining and reporting to the communication device a process for the request based, in the policy, on the second

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user with whom communication is requested is completed (Theimar, column 14 lines 43-48, column 11 lines 6-17), and determining an attribute of a requester based on stored user information or the attribute assigning policy (Theimar, column 11 lines 3-60).

9. With regards to claims 3, 4, 9, 12-13, and 15-22, Theimar, in addition to the features described above, further teaches a first storing means for storing information related to users (Theimar, column 7 line 65 – column 8 line 4), the processing policy including an attribute-assigning policy setting a relationship between the first user requesting communication to the second user (Theimar, column 11 lines 3-6, "policies restricting responses to a subset of all possible clients"), looking up the attribute-assigning policy and information of the first user and the second user (Theimar, column 10 line 66 – column 11 line 17, "check the current settings of the user's policy" and "response..contains information about the user and/or UserAgent that the client is interested in"), authentication means for verifying the communication requestor when a request for communication occurs (Theimar, column 11 lines 3-6), liaising means for acquiring from the communication device the communication requester, requestee, and content of the communication (Theimar, column 10 line 66 – column 11 line 6 and column 14 lines 43-48). Theimar further teaches an information recording means for accepting input of recording in the first storing means the information related to users (Theimar, column 9 lines 54-64, column 10 lines 3-7), a status recording means for accepting input of an recording in the storing means the statuses of the users (Theimar, column 9 line 60 – column 10 line 2), and a policy recording means for accepting input

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of and recording in the storing means the processing policy (Theimar, column 10 lines 3-7).

10. With regards to claims 10, Theimar, in addition to the features described above, further teaches policy recording means accepting input of, and records in the relay terminal (Theimar, column 7 lines 35-40).

11. With regards to claims 6 and 11, Theimar, in addition to the features described above, further teaches an inquiry means for inquiring among communication requestee terminals whether to permit the communication request (Theimar, column 10 line 66 – column 11 line 3) and for obtaining a reply to the inquiry (Theimar, column 11 lines 12-17):

12. With regards to claims 14, Theimar discloses the administering of information related to statuses of the users (Theimar, column 7 lines 1-16, Figure 3), the storing of users requesting the services, content of the requested services, and status of the users related to the request services correlatively with processes for the service requests (Theimar, column 10 line 66 – column 11 line 17). Theimar further discloses that when a service request has been made by one user (Theimar, Figure 4 Item 126), that statuses of the other users related to the service request are obtained (Theimar, column 10 line 66 – column 11 line 3) and based on the one user who requested a service, on the other users related to the requested service, and on the obtained user status, the determining of a process for the service request is completed (Theimar, column 10 line 66 – column 11 line 6 and column 14 lines 43-48).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimar et al US Patent No 5,493,692 in view of Aggarwal et al US Patent No. 5,943,478.

15. With regards to claim 7, Theimar, as described above, teaches a request instructing means for requesting information content related to a terminal from other terminals (Theimar, column 9 lines 7-9), but fails to teach the request occurring if the information is not recorded in the first storing means. Aggarwal teaches the requesting of information content from another terminal if the information content is not stored in the first recording medium (Aggarwal, column 3 lines 41-53). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Aggarwal's information requesting means because it offers the advantage of allowing a terminal to send a message to any other terminal regardless of whether the requesting terminal is known to a terminal previously (Aggarwal, column 1 line 58 – column 2 line 2).



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16. With regards to claim 8, Theimar as modified, fails to teach a peripheral information providing means for providing information content not stored in the first recording means. Aggarwal teaches a peripheral information providing means that provides information content related to terminals to a terminal in order to handle a communication request (Aggarwal, column 3 lines 45-49).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Nalven whose telephone number is 571 272


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3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571 272 3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven



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